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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/728,689 | 12/01/2000 | Eric T. Bax | INFOS 45077 | 5508 |

7590 06/17/2004

Edward G. Poplawski, Esq.
SIDLEY & AUSTIN
555 West Fifth Street
Los Angeles, CA 90013-1010

| EXAMINER |
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VAUGHN, GREGORY J

| ART UNIT | PAPER NUMBER |
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2178

DATE MAILED: 06/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,689

Applicant(s)

BAX ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 12/1/2000.
2. Applicant files Information Disclosure Statement on 7/19/2001.
3. Claims 1-42 are pending in the case, claims 1, 15 and 29 are independent claims.

Priority

4. Applicant's claim for domestic priority of US provisional application 60/195,556, filed 4/6/2000, under 35 U.S.C. 119(e) is acknowledged.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
6. The use of the following trademarks has been noted in this application:
 - "BMW" on page 3, lines 25 and 27.
 - "Mercedes-Benz" on page 3, lines 26 and 27.
 - "Alpha Romeo" on page 7, line 25; page 10, lines 14 and 15.
 - "Volvo" on page 15, line 27; page 16, line 8.
 - "Cadillac" on page 15, line 28; page 16, line 10.

- "VW" on page 16, lines 1 and 12.
- "Acura" on page 20, line 26; page 22, line 9 page 24, line 15 page 25, line 15; (also on pages 26-31).
- "Integra" on page 20, line 26; page 22, line 9 page 24, line 18 page 25, line 15; (also on pages 26-31).
- "Jeep" on page 20, line 28; page 22, line 11; (also on pages 26-31).
- "Cherokee" on page 20, line 28 page 22, line 11; (also on pages 26-31).
- "Toyota" on page 21, line 2 page 22, line 13 page 25, lines 2, 22 and 23; (also on pages 26-32).
- "4Runner" on page 21, line 2 page 22, line 13 page 25, lines 5 and 22; (also on pages 26-32).

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

8. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. The claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. The claims 1-13 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes"*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

11. Claims 1, 14, 15, 28, 29 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by lizuka et al. US Patent 6,424,980, filed 6/9/1999, patented 7/23/2002 (hereinafter lizuka).
12. **Regarding independent claim 1**, lizuka recites: *"extracting required information item by item from different HTML documents that differs in the location, the document structure, and attributes arbitrary"* (column 4, lines 63-65). lizuka further recites: *"FIG. 3 shows an image of operation sequence for user according to the present invention. In FIG. 3, a user enters a search request for, for example, a PC of 100,000 yen or below into an apparatus that realizes the integrated retrieval scheme of the present invention"* (column 11, lines 35-39). Also, lizuka recites: *"Unlike structural data structured item by item such as RDB data, the HTML documents are so called semi-structured data in which data is structured in certain degree by using*

tags, even though HTML documents are plain text basically. For example, data group related to one subject such as table, list and clause involved in HTML document may be contained over several HTML documents, or several data groups may be contained in a single HTML document. It is hard to conditionally retrieve item data corresponding to a given item from these data groups. Search engines have HTML-described input forms that may have fixed search entries or search entries that must be filled in for indication of search condition. The apparatus of the present invention is capable of flexibly coping with a user's search request and providing the user with a collective search result" (column 11, lines 46-61). Iizuka also recites: "The query processing unit 13 acquires the HTML documents, extract information from the HTML documents" (column 12, lines 23-24).

13. **Regarding dependent claim 14**, Iizuka recites: "process for outputting converted second search result in prescribed format for each user that inputs query" (column 42, lines 45-47).
14. **Regarding independent claims 15 and 29**, the claims are directed toward an apparatus and a computer program of the method of claim 1 and are rejected using the same rationale.
15. **Regarding dependent claims 28 and 42**, the claims are directed toward an apparatus and a computer program of the method of claim 14 and are rejected using the same rationale.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

17. Claims 2-13, 16-27 and 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over lizuka in view of Zimmerman et al. US Patent 6,678,694, filed 11/8/2000, patented 1/13/2004 (hereinafter Zimmerman).

18. **Regarding dependent claim 2**, lizuka discloses extracting data from a file as described above. lizuka discloses the use of delimiters to separate data from tags, lizuka recites: *“data pieces corresponding to the items to be extracted contained in the HTML document are separated from one another with delimiters such as tags and slashes”* (column 12, lines 8-9). However, lizuka fails to explicitly mention the use of a space as the delimiter. Zimmerman teaches the use of the space character as a delimiter. Zimmerman recites: *“all punctuation and other special characters are stripped out, leaving only words separated by some delimiter, such as the space character”* (column 13, lines 41-43).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine lizuka's data extraction based upon

delimiters, with Zimmerman's use of the space character as a delimiter, in order to provide *"the analysis procedure 700 that identifies key words and key word pairs within a document and that thereby identifies a word pattern that characterizes the information content of the document"* (Zimmerman, Column 13, lines 30-33).

19. **Regarding dependent claim 3**, lizuka recites: *"the query conversion unit 132 refers to the domain conversion function table 156, fetches a conversion function "Shi2ValueB()," and converts "Yokohama city" into "07" that indicates the seventh entry in a selection list in the input form of the Page-B"* (column 27, lines 41-47).
20. **Regarding dependent claim 4**, lizuka discloses in Fig 22, a *"Document Item Table"* wherein the word meaning is mapped to a domain (see *"Local Domain"* in the table), and the domain is described in the *"Domain Table"* (shown in Figure 25). lizuka further discloses in Figure 22, the word's relative position in the list (see the *"Page Name"*, *"Column"* and *"Item Name"* columns in the table), and a score related to each word (shown in the *"Availability"* and *"Conditional"* columns of the table).
21. **Regarding dependent claim 5**, the claim is rejected for fully incorporating the deficiencies of the base claims.
22. **Regarding dependent claim 6**, lizuka discloses in Fig 22, a *"Document Item Table"* wherein the word meaning is mapped to a domain (see *"Local Domain"* in the table), and the domain is described in the *"Domain Table"* (shown in Figure 25), and where the domain table identifies predefined expressions (see the last two rows of the *"Domain Table"* where the domain group is *"Tel"*). lizuka further discloses in

Figure 22, the word's relative position in the list (see the "*Page Name*", "*Column*" and "*Item Name*" columns in the table), and a score related to each word (shown in the "*Availability*" and "*Conditional*" columns of the table).

23. **Regarding dependent claim 7**, lizuka discloses in Fig 14, a "Domain Table" wherein the domains listed are for "*Price*" and "*Yen*".
24. **Regarding dependent claim 8**, lizuka discloses in the "*HTML Document Item Table*" as shown in Fig 22, where the item has received a high score (shown in the "*Availability*" and "*Conditional*" columns of the table), the region associated with the high score shown as "*Name Tag*". lizuka further discloses in Figure 24 creating sub-regions using the region of interest (shown as "*Column 1*", "*Column 2*" etc.).
25. **Regarding dependent claim 9**, lizuka discloses in Figure 27, using the sub-region to identify records (shown as "*Domain Group*") to identify the record and text for the record (shown as "*User Input Domain*" and "*User Output Domain*").
26. **Regarding dependent claims 10 and 11**, lizuka discloses in Figure 27, user attribute values (shown as "*User Output Domain*").
27. **Regarding dependent claim 12**, lizuka discloses in Figure 9A, an extracted dollar amount (shown as "*Price*").
28. **Regarding dependent claim 13**, lizuka recites: "*process for outputting converted second search result in prescribed format for each user that inputs query*" (column 42, lines 45-47).

29. **Regarding dependent claims 16-27**, the claims are directed toward an apparatus of the method of claims 2-13 respectively, and are rejected using the same rationale.
30. **Regarding dependent claims 30-41**, the claims are directed toward a computer program of the method of claim 2-13 respectively, and are rejected using the same rationale.

Conclusion

31. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| <u>Patent</u> | <u>Date</u> | <u>Inventor</u> |
|----------------|-------------|------------------|
| • US-5,181,162 | 01-1993 | Smith et al. |
| • US-5,768,578 | 06-1998 | Kirk et al. |
| • US-5,845,304 | 12-1998 | Iijima, Yukio |
| • US-5,978,800 | 11-1999 | Yokoyama et al. |
| • US-5,995,943 | 11-1999 | Bull et al. |
| • US-6,108,677 | 08-2000 | Kiuchi et al. |
| • US-6,405,199 | 06-2002 | Carter et al. |
| • US-6,424,980 | 07-2002 | Iizuka et al. |
| • US-6,507,855 | 01-2003 | Stern, Thomas A. |
| • US-6,546,133 | 04-2003 | Temkin et al. |
| • US-6,725,425 | 04-2004 | Rajan et al. |

NON-PATENT DOCUMENTS

- J. Ambite and C. Knoblock, "Agents for Information Gathering", September/October 1997, IEEE Expert: Intelligent Systems and Their Applications. pgs 1-3
- N. Ashish and C. Knoblock, "Semi-automatic Wrapper Generation for Internet Information Sources", 1997, Proceedings of the Second IFCIS International Conference on Cooperative Information Systems, Kiawah Island, SC Pgs 1-10

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- J. Hammer et al., "Extracting Semistructured Information from the Web", 1997, Workshop on Management of Semistructured Data, pgs 1-8
- N. Ashish and C. Knoblock, "Wrapper Generation for Semi-Structured Internet Sources", 1997, Proceedings of the Workshop on Management of Semistructured Data, pgs 1-8

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
June 3, 2004



STEPHEN S. HONG
PRIMARY EXAMINER